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09/924,621	08/07/2001	Satoru Matsuda	112857-282	3175

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EXAMINER
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SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/924,621

Applicant(s)

MATSUDA ET AL.

Examiner

Mohammad A. Siddiqi

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-18 and 35 are presented for examination. Claims 19-34 have been withdrawn from the consideration.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (description of controlling recording paragraphs 11-26 in specification is vague). Applicant is required provide the specific page and line numbers within the disclosure which describe the claimed structure and acts.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

6. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "recording control" in claim 1 is used by the claim to mean "personal information and second information is recorded", while the accepted meaning is "storing attributes in the storage device or database." The term is indefinite because the specification does not clearly redefine the term.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-18 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark (6,351,738) (hereinafter Clark) Günter et al. (6,658,568) (hereinafter Ginter).

9. As per claim 1, Clark discloses an information processing device which exchanges a plurality of information with other information processing devices via a network (422, fig 6, col 3, lines 51-56), said information processing device comprising:

first input/output control means for controlling input and output of information to and from a first information processing device of a user (e-commerce system controlling input/output information with customers, 418, 412/422, fig 6, col 11, lines 40-61);

second input/output control means for controlling input and output of information to and from a second information processing device (e-

commerce system controlling input/output information with suppliers, 424, fig 5, col 11, lines 40-61);

wherein said user is registered (annual membership fee, col 6, lines 50-65) as a member of a predetermined group (group purchasing plan, col 5, lines 60-65, col 6, lines 50-65); and

wherein said second information is determined corresponding to said group (discounted purchasing plan for groups, col 5, lines 50-67, col 6, lines 40-65); and

wherein said second input/output control means controls output to said second other information processing device of said first information (discounted purchasing plan for groups, col 5, lines 50-67, col 6, lines 40-65)

Clarks discloses website or dedicated network where customer or participants make a purchase request using a purchase order form. The e-commerce system forwards purchase order via electronic mail and also generates invoice and electronically forwards to the customer (fig 6, col 11, lines 40-60). Clark explicitly does not disclose substituting means for substituting personal information of said user contained in first information of which input is controlled by said first input/output control means with second information corresponding to said personal information of said user on a one-to-one basis; and first recording control means for controlling

recording of said personal information of said user and said second information said personal information of said user and said second information being recorded in a corresponding manner ; wherein said personal information of said user is substituted with said second information by said substituting means. However, Ginter discloses substituting means for substituting personal information of said user contained in first information of which input is controlled by said first input/output control means with second information corresponding to said personal information of said user on a one-to-one basis (fig 17A-17F, does not reveal the consumer's identity anticipates substituting personal information, col 28, lines 37-49; col 32, lines 7); and

first recording control means for controlling recording of said personal information (rights template, col 76, lines 45-65) of said user and said second information such that said personal information of said user and said second information are recorded in a corresponding manner (rights template, col 76, lines 45-65; col 89, lines 60-65; col 90, lines 1-15); wherein said personal information of said user is substituted with said second information by said substituting means (targeted advertising, col 64, lines 41-59). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Clark and Ginter. The motivation would have been developing a collective

business system including participants engaged in a common field of business endeavor, a plurality of suppliers of business support mechanisms of interest to the participants and a for-profit hub business entity for managing transactions between the suppliers, the participants and their customers; Under the system, the independently owned and operated participants are assigned geographically protected business locations, as well as one or more of volume discounts of goods and services, national marketing capacity, discount capital financing for purchase of costly technology and machinery, access to information technology, logistics support or other business support mechanisms (see Clark abstract).

10. As per claim 2, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses personal information of said user is an e-mail address of said user (col 90, lines 16-22).

11. As per claim 3, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses generating means for generating said second information using a hash function (search and retrieval engine, 560(3), fig 51A, col 90, lines 8-11).



12. As per claim 4, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses searching means for searching operational information of said user regarding which recording is controlled by said first recording means based on said second information contained in a third information which is a reply to said first information regarding which input is controlled by said second input/output control means (search and retrieval engine, col 90, lines 8-11); wherein said first input/output control means controls output of said third information to said first other information processing device, based on said personal information of said users searched by said searching means (search and retrieval engine, col 90, lines 8-35).

13. As per claim 5, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses second recording control means for controlling recording of personal attributes information of said user (customer account or information, fig 18); and third recording control means for controlling recording of information identifying said group and attribute information of said group (professional organizations, fig 13); wherein said attribute information of said group contains, of said personal attribute information regarding which recording is controlled by said second recording control means, a predetermined number of sets of personal attribute information common to a plurality of said users registered to said group, in

descending order of degree held in common (see discussion hierarchies, col 25, lines 26-67; col 26, lines 15-67).

14. As per claim 6, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses further comprising verifying means for verifying permission for access to said attribute information of said group regarding which recording is controlled by said third recording control means; wherein said verifying means verifies permission for access to said attribute information of said group based on a contract between said group and the holder of said second other information processing device (certifying authority, fig 13, col 29, line 60 contd. Col 30).

15. As per claim 7, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses searching means for searching for said attribute information of said group regarding which recording is controlled by said third recording control means, based on information for identifying said group regarding which input is controlled by said second input/output control means, in the event that said verifying means verifies the permission to access of said second other information processing device; wherein said second input/output control means controls output of said attribute information of said group searched by said searching means, to said second

other information processing device (search and retrieval engine, col 89, line 60 contd. col 90, lines 1-42).

16. As per claim 8, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses searching means for searching for information for identifying said group regarding which recording is controlled by said third recording control means, based on information corresponding to said attribute information of said group contained in a fourth information regarding which input is controlled by said second input/output control means, in the event that said verifying means verifies the permission to access of said second other information processing device (search and retrieval engine, fig 13, col 89, line 60 contd. col 90, lines 1-42).

17. As per claim 9, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses second input/output control means controls the output of information for identifying said group searched by said searching means to said second other information processing device (search and retrieval engine, fig 13, col 89, line 60 contd. col 90, lines 1-42).

18. As per claim 10, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses first input/output control means controls

the output of said fourth information to said first other information processing device which said user registered to said group has, based on information for identifying said group searched by said searching means (search and retrieval engine, fig 13, col 89, line 60 contd. col 90, lines 1-42).

19. As per claim 11, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses third input/output control means for controlling input and output of information to and from a third other information processing device; verifying means for verifying permission to access personal attribute information of said user regarding which recording is controlled by said second recording control means; and first searching means for searching said personal attribute information of said user regarding which recording is controlled by said second recording control means, based on fifth information regarding which input is controlled by said third input/output control means, in the event that said verifying means verifies permission to access a third other information processing device; wherein said third input/output control means controls the output of said personal attribute information of said user searched by said first searching means to said third other information processing device (search and retrieval

engine, digital certificate, fig 13, col 89, line 60 contd. col 90, lines 1-42).

20. As per claim 12, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses verifying means verifies permission for access to said personal attribute information of said user registered to said group, based on a contract between the holder of said third other information processing device and said group (search and retrieval engine, digital certificate, fig 13, col 89, line 60 contd. col 90, lines 1-42).

21. As per claim 13, the claim is rejected for the same reasons as claim 1, above. In addition, Ginter discloses second searching means for searching for said holder of said third other information processing device which has entered into contract with said group, based on said second information regarding which input is controlled by said second input/output control means (search and retrieval engine, digital certificate, fig 9- 13, col 89, line 60 contd. col 90, lines 1-42).

22. As per claim 14, the claim is rejected for the same reasons as claim 1, above.

23. As per claim 15, the claim is rejected for the same reasons as claim 1, above.

24. As per claim 16, the claim is rejected for the same reasons as claim 1, above. In addition Clark discloses wherein said second information processing device comprises:

third input/output control means (424, fig 5) for controlling input and output of information from and to said first information processing device (purchase order, invoice, 422, 424, fig 5, col 11, lines 1-39);

wherein said third input/output control means controls output of said first information to said first information processing device (purchase order, 422, 424, fig 5, col 11, lines 1-39); and

wherein said third information processing device comprises: fourth input/output control means for controlling input and output of information from and to said first information processing device (422, 424, fig 5, col 11, lines 1-39);

wherein said fourth input/output control means controls input of said first information from said first information processing device (422, 424, fig 5 col 11, lines 1-39).

25. As per claim 17, the claim is rejected for the same reasons as claim 16, above. In addition Ginter discloses said first information processing device further comprises generating means for generating said second information using a hash function (search and retrieval engine, 560(3), fig 51A, col 90, lines 8-11); and

wherein said third information processing device distinguishes said user having said second information processing device which has output said first information to said first information processing device, based on said second information contained in said first information regarding which input is controlled by said fourth input/output control means (search and retrieval engine, digital certificate, fig 13, col 89, line 60 contd. col 90, lines 1-42).

26. As per claim 18, the claim is rejected for the same reasons as claim 16, above. In addition Clark discloses with said third information processing device, said fourth input/output control means control output of a third information which is a reply to said first information containing said second information (elements of, fig 5 col 11, lines 1-39).

27. As per claim 35, the claim is rejected for the same reasons as claims 16 and 18, above.

***Response to Arguments***

28. Applicant's arguments filed 05/11/2006 have been fully considered but they are not persuasive, therefore rejections to claims 1-18 and 35 is maintained.

29. Regard claims 1 and 14 stand rejected under 35 USC 112, first paragraph, failing to comply with written description requirement. Applicant failed to describe structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by the sixth paragraph of 35 U.S.C. 112.

Applicant failed to provide clarification of the correlation and identification of what structure, material, or acts set forth in the specification would be capable of carrying out a function recited in a means or steps plus function claim limitation. If it is not apparent to the examiner where in the specification and drawings there is support for a particular claim limitation reciting a means to accomplish a function, and an inquiry by the examiner for such support is not met. See MPEP.

30. With regard to the 112, second paragraph rejections to claims 1 and 14-16 have been withdrawn.



31. Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

32. In the remarks applicants argued that:

**Argument:** Ginter does not teach or suggest substituting means for substituting personal information of said user contained in first information of which input is controlled by said first input/output control means with second information corresponding to said personal information of said user on a one-to-one basis.

**Response:** Ginter discloses substituting means for substituting personal information of said user contained in first information of which input is controlled by said first input/output control means with second information corresponding to said personal information of said user on a one-to-one basis (fig 17A-17F, does not reveal the consumer's identity anticipates

substituting personal information, col 28, lines 37-49; col 32, lines 7; col 37, lines 55-67; col 41, lines 20-23, user identity information removed to ensure user privacy is another example of substituting, person of ordinary skill in the art knows in the context of the invention that removing requires substituting and that could be simply NULL value ). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Clark and Ginter. The motivation would have been developing a collective business system including participants engaged in a common field of business endeavor, a plurality of suppliers of business support mechanisms of interest to the participants and a for-profit hub business entity for managing transactions between the suppliers, the participants and their customers; Under the system, the independently owned and operated participants are assigned geographically protected business locations, as well as one or more of volume discounts of goods and services, national marketing capacity, discount capital financing for purchase of costly technology and machinery, access to information technology, logistics support or other business support mechanisms (see Clark abstract).

***Conclusion***

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS

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